FISH & RICHARDSON P.C.

PTO/SB/33 (07-06)
Approved for use through xx/xx/20x OMB 0651-00xx
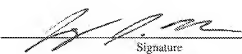U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

| **PRE-APPEAL BRIEF REQUEST FOR REVIEW** | Docket Number. |
| | 06975-100001 |

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number	Filed
	09/624,191	July 24, 2000
	First Named Inventor	
	Mark Donner et al.	
Date of Deposit	Art Unit	Examiner
	2157	Hussein A. El Chanti
Signature		
Typed or Printed Name of Person Signing Certificate	Confirmation No.	
	6404	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
    is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 58,680
        (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34
    Registration number if acting under 37 CFR 1.34

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                          November 20, 2006
                        Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 5 pages are submitted in addition to this Form and the Notice of Appeal.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mark Donner et al.	Art Unit : 2157
Serial No. : 09/624,191	Examiner : Hussein A. El Chanti
Filed : July 24, 2000	Conf. No. : 6404
Title : INSTANT MESSAGING CLIENT HAVING AN EMBEDDED BROWSER	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-38 are pending with claims 1, 12, 17, and 21-26 being independent. Independent claims 1, 12, 17 and 21-26, along with their dependent claims 3, 6-11, 13-16, 18-20, and 27-38 have been rejected under §102(e) as being anticipated by Tsimelzon (U.S. Patent No. 6,834,306). Applicants submit that these rejections are clearly erroneous because the rejections fail to point out a basis within the relied-upon Tsimelzon reference for teaching of at least one feature expressly recited in each of these claims.

1. Tsimelzon does not describe or suggest every feature of claims 1, 12, and 17.

Claims 1, 12, and 17 each recite "creating a user profile including a request to receive at least one alert corresponding to a state change at a remote server" and "instructing the remote server to generate an alert feed in response to the remote server detecting the state change."

The pending rejection of these claims, over Tsimelzon, is not proper because the rejection fails to point out any basis in Tsimelzon for teaching instructing a *remote server* to generate an alert feed corresponding to *a change in state at the remote server* in response to *the remote server detecting the change in state at the remote server.* The only portions of Tsimelzon referenced in the final Office action of July 18, 2006 and the Advisory action of November 2, 2006 with respect to these features are col. 2, lines 1-47, col. 11, lines 30-62, and col. 5, line 52 through col. 6, line 36. None of the identified portions, or any other portion of Tsimelzon,

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describe or suggest instructing a remote server to generate an alert feed corresponding to a change in state at the remote server in response to the remote server detecting the change in state.

In particular, both col. 2, lines 1-47 and col. 11, lines 30-62 describe a server configured retrieve a web page and enable a user to set notification criteria for the page. The notification criteria are stored in the server and include a notification condition, a frequency of checking notification, and a notification device. After the notification criteria have been set, the server periodically retrieves the web page in accordance with the notification frequency to determine if the notification condition has been met and sends a notification if the condition has been met. Nothing in these portions of Tsimelzon, however, teaches the server generating a notification corresponding to a change in state <u>at the server</u> in response to <u>the server detecting</u> the change in state. Rather, the server generates a notification corresponding to a change in state occurring not at the server itself but rather at a device providing the web page. The notification is generated in response to the server detecting that device's change in state. Accordingly, because the server merely retrieves a web page to determine whether the device providing the web page has undergone a state change and the notification generated by the server corresponds to a change in state at the device rather than at the server, col. 2, lines 1-47 and col. 11, lines 30-62 each fail to describe or suggest instructing a remote server to generate an alert feed corresponding to a change in state <u>at the remote server</u> in response to <u>the remote server detecting</u> the change in state.

Moreover, col. 5, line 52 through col. 6, line 36 was cited in the Response to Arguments section of the final Office action of July 18, 2006. In that section, the Examiner clarified that he is equating server 120 in Fig. 1 with the recited remote server. The Examiner explained that server 120 "stores a copy of the shortpage and monitors updates to the shortpage according to a user profile." More specifically, in the Advisory Action mailed on November 2, 2006, the Examiner states that "Tsimelzon explicitly states that server 120 stores a copy of the shortpage." The Examiner submits that Tsimelzon teaches storing a copy of the shortpage because, when a user requests a shortpage from server 120, server 120 sends a copy of the shortpage and, when a user requests server 120 to delete a shortpage, server 120 deletes the shortpage. See Advisory Action of November 2, 2006 at page 2. As best understood, the Examiner is interpreting Tsimelzon to describe server 120 as storing web page content on server 120 and sending a notification to a user corresponding to a change in the stored web page content on server 120.

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This characterization of Tsimelzon is clearly erroneous because Tsimelzon does not describe that server 120 stores a copy of the shortpage. Rather, server 120 merely "stores selection information 122 describing shortpages." See Tsimelzon at col. 4, lines 39-41. The Examiner argues that server 120 stores a copy of the shortpage because server 120 sends a copy of the shortpage when requested. However, server 120 does not send a copy of the shortpage stored on server 120. Tsimelzon explicitly describes that "[w]hen the server receives a request f[ro]m the client's browser to ... view a shortpage ..., the server translates the request into the appropriate request(s) to the web server(s) ... and retrieves the requested web page(s) or site(s) from the server(s) .... The server does the user-specified action such as ... selecting the relevant parts of the web page (when a shortpage is to be viewed)." See Tsimelzon at col. 6, lines 37-50. When a user requests a shortpage, server 120 requests web page content from web page servers rather than accessing web page content stored on server 120. Nowhere does Tsimelzon describe that server 120 sends the user a copy of a shortpage stored on server 120. In addition, deleting a shortpage does not delete web page content of the shortpage stored on server 120, but instead deletes the selection information describing the shortpage stored on server 120. Because server 120 does not store a copy of the shortpage, server 120 does not monitor updates to a shortpage stored at server 120. The change monitored by server 120 is a change in web page content hosted by the web server 132, 134, or 136. As such, server 120 is not instructed to generate an alert feed in response to server 120 detecting a change in state at server 120 because no such change occurs. Because server 120 sends a notification in response to detecting a change in a web page stored at web server 132, 134, or 136 and not in response to detecting a change in the selection information (or any other information) stored at server 120, server 120 is not instructed to generate an alert feed in response to server 120 detecting a change in state at server 120.

Thus, the Examiner has failed to meet his burden of pointing out where Tsimelzon describes or suggests instructing a remote server to generate an alert feed corresponding to a change in state at the remote server in response to the remote server detecting the change in state.

Because Tsimelzon does not meet every limitation recited in independent claim 1, 12, and 17 applicants submit that the Examiner has not made a proper anticipation rejection. Accordingly, the rejection of independent claims 1, 12, and 17 and their dependent claims 3, 6-11, 13-16, 18-20, and 27-38, should be withdrawn.

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Claims 2, 4, and 5 have been rejected as being unpatentable over Tsimelzon in view of Atsmon (U.S. Patent No. 6,607,136). Claims 2, 4, and 5 depend from claim 1. Atsmon does not remedy Tsimelzon's failure to describe or suggest instructing a remote server to generate an alert feed in response to the remote server detecting a change in state at the remote server. Accordingly, applicants request withdrawal of the rejection of claims 2, 4, and 5.

2. *Tsimelzon does not describe or suggest the additional features of claims 28, 30, 32, 34, 36 and 38 depending from claims 1, 12, and 17.*

Claims 28, 32, and 36 each recite that "the state change at the remote server comprises a change to monitored content stored at the remote server." Tsimelzon fails to describe or suggest that the state change at the remote server comprises a change to monitored content stored at the remote server. Specifically, as discussed above, the server that generates a notification described at col. 2, lines 1-47 and col. 11, lines 30-62 of Tsimelzon does not store monitored content. Rather, the server that generates a notification merely stores selection information and notification criteria and monitors content stored at web page servers. As such, the server does not experience a change in monitored content stored at the server.

Claims 30, 34, and 38, each recite, *inter alia*, that "instructing the remote server to generate an alert feed upon occurrence of a change in the content." Col. 2, lines 1-47 and col. 11, lines 30-62, the portions of Tsimelzon referenced by the Examiner, fail to describe or suggest instructing the remote server to generate an alert feed upon occurrence of a change in content. In particular, a notification is not generated "upon occurrence" of a change in content. Rather, the server periodically retrieves a web page according to a specified time interval and generates a notification if a condition is met at the time of access. Nothing related to notification happens "upon occurrence" of a change in the web page content provided by the web page servers. Thus, the Examiner has failed to meet his burden of pointing out where Tsimelzon describes or suggests instructing the remote server to generate an alert feed upon occurrence of a change in content. Notably, in the Advisory action of November 2, 2006, the Examiner failed to address the arguments with respect to the additional features of claims 28, 30, 32, 34, 36 and 38 presented in the Reply to Final Office Action filed on October 18, 2006.

Because neither the cited portions of Tsimelzon nor any other portions of Tsimelzon meet the additional limitations recited in dependent claims 28, 30, 32, 34, 36 and 38, applicants submit that the Examiner has not made a proper anticipation rejection for at least these additional reasons and the rejection should be withdrawn.

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3. *Tsimelzon does not describe or suggest every feature of claims 21-26.*

Claims 21-26 each recite instructing or a host configured to instruct the *remote server* to broadcast alert feeds *in response to changes of state at the remote server* (emphasis added). The only portion of Tsimelzon referenced throughout prosecution with respect to this features is col. 12, line 10 through col. 13, line 50. Similar to the description of Tsimelzon discussed above with respect to claims 1, 12, and 17, this portion of Tsimelzon does not describe or suggest instructing a *remote server* to broadcast alert feeds in response to *changes of state at the remote server*. In addition, this portion of Tsimelzon does not describe or suggest sending a notification *in response to* changes of state at the remote server. Rather, the server periodically retrieves a web page according to a specified time interval and generates a notification if a condition is met at the time of retrieval. Nothing happens in response to the change in web content stored at the web page servers. Notably, the Examiner has omitted the "in response to changes of state at the remote server" language from claims 21-26 when describing the rejection. This is clear error.

Because neither col. 12, line 10 through col. 13, line 50 of Tsimelzon nor any other portion of Tsimelzon describes or suggests instructing a remote server to broadcast alert feeds in response to changes of state at the remote server and the Examiner has failed to even address this specific claim language in the rejection, the Examiner has not made a proper anticipation rejection and the rejection of independent claims 21-26 should be withdrawn.
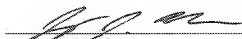
4. *Conclusion and Relief.*

For at least the reasons noted above, the rejections of record are clearly improper and without basis. Applicant submits that all of the claims are in condition for allowance.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: __11 / 20 / 06__

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